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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,489	02/18/2004	Gary S. Fanton	FAN-1(027-001)	5632
27300 7590 06/01/2009 PANDISCIO & PANDISCIO, P.C. 470 TOTTEN POND ROAD WALTHAM, MA 02451-1914			EXAMINER EREZO, DARWIN P	
			ART UNIT 3773	PAPER NUMBER
			MAIL DATE 06/01/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/782,489	Applicant(s) FANTON ET AL.	
	Examiner Darwin P. Erez	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 9-19, 23-36, 38 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 20-22, 37, 39-45 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/2/04, 11/04/04 and 9/6/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Specie I in the reply filed on 3/13/09 is acknowledged.
2. Claims 9-19, 23-36, 38 and 46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected specie, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/13/09.

Information Disclosure Statement

3. The information disclosure statement(s) (IDS) submitted on 8/2/04, 11/04/04 and 9/6/07 have been received and made of record. Note the acknowledged form PTO-1449 enclosed herewith.

Drawings

4. The drawings were received on 11/4/04. These drawings are acceptable.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 8, 37, 39-45 and 47 is rejected under 35 U.S.C. 102(b) as being anticipated by US 4,560,375 to Schulte et al.

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Schulte discloses an apparatus capable of clearing an obstruction from a cutting instrument, the apparatus comprising: a handle 124; means for interrupting configured to interrupt aspiration flow in tubing coupled to the cutting instrument (where element 148 is pointing towards in Fig. 5); and means for flushing configured to flush fluid in the tubing, situated distal to the means for interrupting, in a distal direction (where element 138 is pointing towards in Fig. 5); further comprising a bulb-shaped, actuation means (see Fig. 3); wherein the means for is fully capable of compressing a section of the tubing (note that the tubing is not a positively recited structure in the claim 8); wherein a section of tubing 114 is disposed within the handle; wherein the means for interrupting is disposed adjacent and encircles said tubing; wherein the device includes a line 112 capable of being an irrigation supply; a one-way valve 144; wherein tubing 114 and 112 are a plurality of tubing; wherein the means for interrupting and means for flushing is capable of being actuated sequentially.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 4-7 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulte et al, as applied to the rejections above.

Schulte discloses all the limitations of the claims, including the means for flushing comprises at least one fluid chamber; wherein the fluid chamber comprises a liquid, wherein compression of the fluid chamber is configured to cause compression of the tubing; and further comprising at least one interior compression member disposed distal to the inward protrusion and configured to 15 selectively apply a compressive force upon the tubing. Schulte is silent with regards to the means for interrupting comprises an inward protrusion and the fluid chamber comprising air. Instead, Schulte discloses the opposite with tube 114 expanding outwardly (the portion that holds valve 140) to form a protrusion that engages the inner surface of the means for interrupting.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the

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device of Schulte to have the protrusion on the means for interrupting instead of the tube 114 since it has been held that a mere reversal of essential working parts of a device involves only routine skill in the art. *In re Gazda*, 219 F.2d, 449, 104 USPQ 400 (CCPA 1955). It is also noted it would be obvious to have air in the fluid chamber instead of fluid since either type would provide the same function of providing pressure to clear any obstruction in line 112 when used with a cutting instrument.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erezzo whose telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erez/
Primary Examiner, Art Unit 3773